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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,877	07/11/2006	Dieter Urban	293249US0PCT	7723

22850 7590 05/07/2010  
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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SASTRI, SATYA B

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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05/07/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/585,877	<b>Applicant(s)</b> URBAN ET AL.	
	<b>Examiner</b> SATYA B. SASTRI	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 and 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-13, 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. This office action is in response to amendment filed on 1/29/10. Claims 1-20 are now pending in the application with claims 1-9, 14-16 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

#### ***Claim Rejections - 35 USC § 112/101***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 10-13, 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Presently recited claim 10 recites a method of using a dispersion or solution as adhesive, sealant or impregnating composition. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Additionally, absent a recitation of what is being impregnated, the scope of the term "impregnating composition" is unclear. Claims 11-13, 17-20 depend on the rejected base claim.

Claims 10-13, 17-20 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*,

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255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

*Previously Cited Statutes*

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 10, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messersmith et al. (US 20030087338 A1).

Messersmith et al. disclose adhesive 3,4-dihydroxyphenyl-L-alanine (DOPA)-containing polymers (ab.). DME-PAO8 and DOPA-PAO8 in scheme I derived from PLURONIC® F68 with molecular wt. of 8,400 meet the limitation of at least 0.001 mol of 3,4-dihydroxyphenyl groups per 100g of polymer. The surface modification may be affected by using a catecholic and/or DOPA component as a solution or in liquid medium comprising aqueous or organic solvents for the biomimetic adhesive composition (0095, 0097). The compositions are capable of use on various substrates under water due to tenacious bonds formed by DOPA moieties (ab.).

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messersmith et al. (US 20030087338 A1) in view of Wilson et al. (US2,685,515).

The discussion with regard Messersmith et al. above in paragraph 5 is incorporated herein by reference.

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The prior art fails to disclose the method of using the coating wherein it is stored under oxygen-free condition prior to use.

Secondary reference to Wilson et al. concerns the use of polyhydric alcohols. Further, the prior art discloses that polyhydric alcohols such as catechol or pyrogallol show serious disadvantages such as a strong tendency to form colored oxidation products upon contact with oxygen in the air (col. 2, lines 23-32). Given that the copolymer of Messersmith et al. include aromatic polyhydric alcohols having hydroxyl groups ortho to each other such as catechol and pyrogallol and given the teaching by Wilson et al. on their reactivity with oxygen, it would have been obvious to one of ordinary skill in the art to store the coating composition of Messersmith et al. under oxygen free environment prior to its use.

### ***Response to Arguments***

7. Applicant's arguments have been duly considered but are deemed moot in view of the new grounds of rejections set forth above. All previous rejections are withdrawn and the office action properly remains a nonfinal.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satya Sastri at (571) 272 1112. The examiner can be reached on Mondays, Thursdays and Fridays, 7AM-5.30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. David Wu can be reached on 571-272-1114.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Satya B Sastri/

Examiner, Art Unit 1796